

## REMARKS

This paper is filed in response to the Office Action mailed on November 6, 2001. Claims 57-83 are pending in the application. In the Office Action, Claims 62-64, 66, 67, 70, 71, and 73-83 were withdrawn from consideration. Claims 57-61, 65, 68, 69, and 72 were examined and have been rejected. Claims 57-73 and 75-80 are amended herein. Reconsideration and reexamination of the claims is respectfully requested.

### The Withdrawal of Claims 62-64, 66, 67, 70-71, and 73-83

Claims 62-64, 66, 67, 70-71, and 73-83 were withdrawn from further consideration by the Examiner pursuant to 37 C.F.R. 1.142(b) as being drawn to a non-elected species for purportedly there being no allowable generic or linking claim. Applicants respectfully disagree with the Examiner's conclusions.

The Office Action mailed on September 11, 2001, identified species of several of the aspects of the claimed invention. For example, the Examiner suggested that an engagement member has species A, B, C, and D shown in FIGURES 13-16, 27, 28, and 37; a highback has species A shown in FIGURES 21 and 22; and an inner shell has species A and B shown in FIGURES 25 and 26. Applicants understood the restriction requirement of the September 11 Office Action to be directed to one species of one aspect of the invention and therefore elected the species identified in FIGURES 13-16. Applicants submit that a more proper restriction would include election of one species of engagement member, one species of inner shell, and one species of highback, and not just one species of one aspect of the invention. In any event, the elected species of the *invention* shown in FIGURES 13-16 also comprises a highback and inner shell. However, by the nature of FIGURE 16, only some aspects of the inner shell and highback are shown (some in phantom). The elements of the highback and inner shell are nonetheless understood to be present in the species of invention embodied by FIGURE 16. Applicants

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

submit that the elected species of invention is then specific to the engagement member 122, but non-specific with respect to the highback and inner shell.

With this understanding of the invention embodied by FIGURE 16, applicants submit that Claims 57-60 and 65-83 are generic, while Claims 57-61 and 65-83 read on the elected species of the engagement member. Applicants also submit that if a claim is not mutually exclusive of the elected species of the engagement member, it should be considered generic, since a generic claim should include no further limitations other than what are found in the species of the invention. Thus, Claims 57-60 and 65-83 are generic for at least not excluding the possibility, by the use of the open language "comprising," that the invention defined by these claims, in addition to including an engagement member, may also include an inner shell and a highback of whatever species.

Thus, Claims 57, 65 and 74 would read on FIGURES 21 and 22 because it is understood from the entirety of the specification that the invention of FIGURE 16 comprises an engagement member, highback and cable members. FIGURE 16 shows a highback and aspects of the shell, such as cables. FIGURES 21 and 22 intend only to show the aspects of the highback of the invention. See page 5, lines 31-33. Claims 57, 65 and 74 also read on FIGURES 35 and 36 because these figures show the engagement member 122 and cable members 126. FIGURES 35 and 36 intend only to show the shell aspect of the invention. See page 5, lines 23-27. In this case, applicants respectfully submit that a species of invention is defined too narrowly by reliance on one figure alone. The figures must be interpreted in conjunction with the description as a whole to determine a true species of invention; therefore, Claims 57, 65 and 74 are generic. Furthermore, applicants respectfully request to have Claim 74 reinstated and examined in light of the reasons given above. If a generic claim exists and is found allowable, a reasonable number of species are permitted.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>LLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

The Examiner is saying that Claims 66, 67, 70, 71, 73, 74, and 75 do not read on the elected species of FIGURE 16. With regard to Claims 70-71, "pulley" refers to an adjustment at the front of the inner shell that slides in a slot, for example slot 240 of FIGURE 36. See page 15, line 34, through page 16, line 2. With regard to Claims 66 and 67, cable members are shown looping around the pulley (in phantom) in FIGURE 16, which is intended to be adjusted (altered) in the slot (not shown). Claims 74 and 75 refer to an ankle strap and lace. As explained above, the invention embodied by FIGURE 16 is understood to also include the elements of the inner shell, though they are not shown in this particular figure. Thus, Claims 66, 67, 70, 71, 73, ~~74~~, and 75 read on the elected species. In any event, even in FIGURE 36, an engagement member 122 is shown; therefore, even if Claims 66, 67, 70, 71, 73, 74, and 75 are mutually exclusive species of an inner shell, FIGURE 36 includes a non-specific engagement member and thus these claims also read on the elected species of engagement member.

*how about 2" of each other*  
*when*

Therefore, applicants respectfully request that the withdrawn Claims 62-64, 66, 67, 70, 71, and 73-83 be reinstated and examined in view of the patentability of at least one or more generic claims. Thus, Claims 57-83 are now in condition for allowance. In any event, independent Claim 57 is at least generic to all embodiments of the engagement member; therefore, at least Claims 62-64 are entitled to be reinstated in the case.

#### The Objection to the Information Disclosure Statement

Documents identified as F1-F8 in the Information Disclosure Statement filed on May 21, 2001, are enclosed herewith. Applicants respectfully request that the references be considered. English abstracts are provided for the references not in the English language, except for DE 68807537.0.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>LLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

The Rejection of Claims 58-61, 65, 68, 69, and 72 Under 35 U.S.C. § 112

Claims 58-61, 65, 68, 69, and 72 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention; specifically, the Examiner is saying that the boot has only been functionally recited. Applicants respectfully disagree that the claims are indefinite. Applicants submit that the claims are ascertainable to persons of ordinary skill. The fact that "boot" may be defined functionally does not render the claims indefinite. In any event, the claims have been amended to expedite the issuance of a patent and not for any reason related to patentability, making the rejection moot.

With regard to Claim 65, the word "an" is an obvious typographical error of the word "and"; thus, this claim is submitted to be ascertainable to a person skilled in the art. In any event, Claim 65 has been amended to expedite the issuance of a patent and not for any reason related to patentability, making the rejection moot.

In view of the foregoing remarks, Claims 58-61, 65, 68, 69, and 72 are submitted to be allowable.

The Rejection of Claims Under 35 U.S.C. § 102

Claims 57-61, 65, 68, 69, and 72 are rejected under 35 U.S.C. § 102(b) as being anticipated by DE 3822113 to Lederer. Lederer appears to show cable members 2666m configured to also push from a side direction relative to the length of the boot 2646 to urge two members 2666 around the back and sides of the foot. FIGURE 33 of Lederer shows one embodiment wherein arrows 2273 show that the applied force is from a direction acting on the sides and rear of the foot. In contrast, the present invention provides cable members that are configured over a guide so that tension is applied in a manner to urge the highback portion of the boot forward. The highback of the claimed invention flexes forwards and backwards as tension

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

is applied or released from the cable members. Lederer does not appear to disclose structure for flexing a highback portion of a boot forward or backwards, since the cables are vertically interlaced at the rear of the foot, the forces would seem to push against the whole back of the foot, from heel to calf. Furthermore, the cable attachments 2674 of Lederer appear to be to the rear of the boot 2646, and thus the cables cannot act to urge a highback forward. Because the reference fails to exactly teach the invention as now claimed, the reference is not anticipatory, and withdrawal of this ground for rejection is respectfully requested.

Neither is the claimed invention obvious in view of Lederer. Obviousness requires a suggestion or motivation either in the cited references or in the knowledge generally available to modify the references (or combine references), in addition to requiring that every element be taught or suggested. There appears to be no suggestion or motivation for modifying the cable members of Lederer in the claimed manner. In fact, the principles of operation between the claimed invention and Lederer are quite distinct from one another, so that the reference, in essence, teaches away from the claimed invention. Without limitation, one aspect of the present invention provides an easily adjustable device to change the forward or backward lean of a snowboard rider's foot. In contrast, the reference appears to be addressed to a boot with a hard outer shell made to more securely fit a number of different skiers. To that end, it appears that interior corset-like bindings have been provided at the forefoot instep region and at the heel that secure a skier's foot within the hard outer shell. In this manner, a one-sized outer shell can accommodate different skiers. Accordingly, Claims 57-61, 65, 68, 69, and 72 are neither anticipated nor obvious in view of Lederer.

Furthermore, dependent Claims 62-64, 66, 67, 70, 71, 73, and 76-80 depend from either Claim 57 or Claim 65, which are neither anticipated nor obvious in view of Lederer; therefore, these dependent claims are also allowable.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

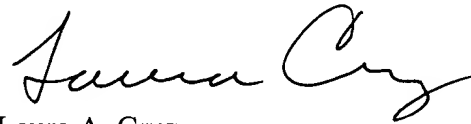
With regard to Claim 74, applicants submit that this claim is generic and reads on the elected species of invention. Therefore, this claim and all dependent claims therefrom, should be examined and found allowable. In any event, Claims 57 and 65 are generic and allowable; therefore, a reasonable number of species are entitled to be included in the application.

#### CONCLUSION

In view of the foregoing amendment and remarks, applicants submit that Claims 57-83 are in condition for allowance. If any issues remain that may be resolved in a telephone interview, the Examiner is encouraged to telephone the undersigned attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



Laura A. Cruz  
Registration No. 46,649  
Direct Dial No. 206.695.1725

#### **EXPRESS MAIL CERTIFICATE**

"Express Mail" mailing label number EL 742878164 US

Date of Deposit February 6, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to the Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 2327, Arlington, VA 22202.

Dennis Hanson

(Typed or printed name of person mailing paper or fee)



(Signature of person mailing paper or fee)

LXC:cjh/tm/gjm

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

VERSION WITH MARKINGS TO SHOW CHANGES MADE FEBRUARY 6, 2002

In the Claims:

57. (Amended) A [forward lean adjustment system for a] boot comprising:  
a flexible highback portion located at the rear of the boot;  
medial and lateral side cable members <sup>126</sup> on the boot for urging [a] the highback portion [of the boot] forwardly along medial and lateral sides thereof; and  
a tension adjustment member connected to the cable members for altering the length of said cable members, to provide more or less forward lean of the boot relative to a vertical line.
58. (Amended) A [forward lean adjustment system] boot according to [claim] Claim 57, wherein forward ends of said medial and lateral side cables attach to a forward portion <sup>140</sup> of the boot on a location at one side of the boot.
59. (Amended) A [forward lean adjustment system] boot according to [claim] Claim 58, wherein said location is on a medial side of the boot.
60. (Amended) A [forward lean adjustment system] boot according to [claim] Claim 57, wherein said tension adjustment member comprises an engaging arm <sup>120</sup> pivotally attached to a rear portion of the boot.
61. (Amended) A [forward lean adjustment system] boot according to [claim] Claim 60, wherein said arm includes <sup>128, 130</sup> plural engaging members for selective engagement of said cables to lengthen or shorten the effective length of the cables.
- w/0 62. (Amended) A [forward lean adjustment system] boot according to [claim] Claim 60, wherein said plural engaging members comprise slots and wherein said cables carry keeper members adapted to fit in [ones] one of said slots.
- w/1 63. (Amended) A [forward lean adjustment system] boot according to [claim] Claim 60, wherein said tension arm comprises an adjustable threaded member connected to said

cables, wherein adjustment of said threaded member alters the effective length of said cables for altering the forward lean of the boot.

w/d 64. (Amended) A [forward lean adjustment system] boot according to [claim] Claim 63, wherein said adjustable threaded member is in threaded engagement with a pulley and adjustment of said threaded member alters the position of said pulley, said pulley receiving said cables thereon, thereby altering the effective length of said cables.

65. (Amended) A [forward lean adjustment system for a] boot comprising:  
a flexible highback portion located at the rear of the boot;  
medial and lateral side cable members <sup>126</sup> on the boot for urging [a] the highback portion [of the boot] forwardly along medial and lateral sides thereof, wherein said medial [an] and lateral side cable members attach to a front portion of the boot at a region thereon.

w/d 66. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 65, wherein said region comprises first and second locations that are within 2 inches of each other.

w/d 67. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 65, wherein said region comprises first and second locations that are within 1 [inches] inch of each other.

68. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 65, wherein said region comprises first and second locations that are substantially adjacent each other.

69. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 65, wherein said region comprises a substantially single position.



w/D 70. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 69, wherein said single position comprises a pulley member attached to a front portion of the boot.

w/D 71. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 70, further comprising means for adjusting the relative position of said pulley member on the front portion of the boot.

72. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 65, wherein said medial and lateral side cable members comprise portions of a continuous cable and wherein said cable loops back from the medial side to the lateral side of the boot around a loop back member at a front portion of the boot.

w/D 73. (Amended) A [forward lean adjustment system for a] boot according to [claim] Claim 65, further comprising means for altering the location of said single position on the front of said boot.

w/D 74. (Amended) A snowboard boot according to [claim] Claim 74, wherein said ankle strap further comprises a lace receiving portion for receiving a lace of the boot therethrough, for securing said ankle strap to the snowboard boot.

76. (Amended) A [forward lean adjustment system for a] boot according to Claim 65, further comprising a calf plate pivotally attached to the highback portion.

77. (Amended) A [forward lean adjustment system for a] boot according to Claim 76, wherein the calf plate includes reinforcing ribs.

78. (Amended) A [forward lean adjustment system for a] boot according to Claim 76, wherein the highback portion includes a first and second member pivotally connected to each other.

w/D 79. (Amended) A [forward lean adjustment system for a] boot according to Claim 76, wherein the highback portion is laterally and medially adjustable.

w/D 80. (Amended) A [forward lean adjustment system for a] boot according to Claim 79, wherein the highback portion includes fasteners received within slots to allow lateral and medial movement.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100